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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,441	10/16/2000	Bayard S. Webb	0112300/141	1896

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EXAMINER

ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 03/18/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/688,441

Applicant(s)

WEBB ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-33 is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

Claim 1, 2, 12, 13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Barrie*, GB 2,144,644 A (Mar. 13, 1985) in view of *Kamille*, U.S. Patent 5,855,514 (Jan. 5, 1999).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 3, 4, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Barrie* in view of *Kamille*, as applied to claims 1 and 2 above, in further view of *Demar et al.*, U.S. Patent 6,203,429 B1 (Mar. 20, 2001).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 14, 17 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Barrie* in view of *Kamille*, as applied to claims 1 and 2 above, in further view of *Yoseloff et al.*, U.S. Patent 6,427,208 B2 (Oct. 29, 2002).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 5-10 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Barrie* in view of *Kamille* and *Demar*, as applied to claim 3 above, in further view of *Yoseloff*.

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This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Allowable Subject Matter

Claims 29-33 are allowed.

Response to Arguments

Applicant's arguments filed January 12, 2004 have been fully considered but they are not persuasive.

The applicant argues that the rejection of claims 1-18 and 20-33 over the combination of Barrie with Kamille is improper because Barrie teaches away from the combination. In particular, the applicant asserts that Barrie cannot be combined with Kamille to show the claimed feature of assigning an item to all symbols because Barrie requires the assignment of at least two classes of items to the set of symbols. The examiner respectfully disagrees.

The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972). Consideration must be given to portions of a reference that lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)¹. A combination is improper where references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).²

¹ Claims were directed to a process of producing a porous article by expanding shaped, unsintered, highly crystalline poly(tetrafluoroethylene) (PTFE) by stretching said PTFE at a 10% per second rate to more than five times the

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In this case, neither Barrie nor Kamille disclose that an item should not be assigned to all symbols. Rather, Kamille teaches that the feature was known in the art at the time of the invention. *See col. 1:56-2:4*. Moreover, Kamille expressly suggests incorporating the feature into a selection game to allow a single game to offer multiple payouts. *See col. 6:17-23*.

Furthermore, the portions of Barrie cited by the applicant do not teach away from the combination with Kamille when the references are considered in their entirety. In particular, the applicant argues that Barrie teaches away from assigning one item to all symbols because the game requires assignment of at least two classes of items (e.g. win or lose outcomes). This argument is unpersuasive for several reasons. First, Kamille provides games analogous to Barrie in which two classes of items are awarded. *See, e.g., fig. 7C (showing a game having outcomes including win, lose, award, and combinations thereof)*. Second, Kamille describes selections having more than one class of outcome assigned. *See fig. 7C; col. 5:21-32*. Third, similar to Barrie, Kamille describes games in which players may opt to quit the game for a current award, or to continue making selections at the risk of losing a current award. *See col. 6:3-16*. Hence, the combination of Barrie with Kamille collectively suggests a selection game in which an award item is assigned to all selections and, in addition, one or more win-outcomes are assigned to selections allowing players to advance to a subsequent round.

Thus, when Barrie and Kamille are taken as a whole by an artisan, the combination does not teach away from a selection game wherein an item is assigned to all symbols.

original length. *The prior art teachings with regard to unsintered PTFE indicated the material does not respond to conventional plastics processing, and the material should be stretched slowly.* A reference teaching rapid stretching of conventional plastic polypropylene with reduced crystallinity combined with a reference teaching stretching unsintered PTFE would not suggest rapid stretching of highly crystalline PTFE, in light of the disclosures in the art that teach away from the invention, i.e., that the conventional polypropylene should have reduced crystallinity before stretching, and that PTFE should be stretched slowly. (Emphasis added.)

² The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference *expressly* excluding antimony from, and adding iron to, a catalyst. (Emphasis added.)

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The applicant further argues that the claims, as amended, distinguish over the combination of Barrie in view of Kamille because the prior art does not suggest the feature of assigning an item to a different number of symbols in each of a plurality of rounds. The examiner respectfully disagrees. The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972).

In this case Barrie teaches a gaming device having a plurality of rounds in which the odds of selecting a winning outcome change with each round. *See fig. 5-8*. Each round constitutes a distinct game in which outcomes are randomly distributed to selections. *See pp. 2:113-3:82*. Kamille teaches controlling a game's probability by allocating different numbers of winning and losing outcomes to each game. *See col. 5:6-20*. Hence the combination of Barrie with Kamille, when taken as a whole by an artisan at the time of the invention, suggests assigning an item to a different number of symbols in each of a plurality of rounds. As taught by Kamille, the modification allows a game operator to control his prize liability. *See col. 3:52-55, 7:3-16*.

Consequently, for the reasons given above the rejection of claims 1-18 and 20-28 is respectfully maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end

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of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.



MARK SAGER
PRIMARY EXAMINER